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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,652	05/17/2001	Koichiro Kashiwagi	NEC N01270	3896

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EXAMINER	
SINGH, RAMNANDAN P	

ART UNIT	PAPER NUMBER
2644	4

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/859,652	KASHIWAGI, KOICHIRO	
	Examiner	Art Unit	
	Dr. Ramnandan Singh	2644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 May 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification

Content of Specification

1. (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

2. Abstract of the Disclosure must be in a single paragraph. An appropriate correction is required.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy in **Japanese** has been filed on 07 July 2003.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7, 9-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Beamish [US 6,404,863 B1].

Regarding Claim 1, Beamish teaches a telephone set 20 [col. 1, lines 8-13; col. 2, lines 55-63], as shown in Fig. 1, comprising base electronics 30, an acoustic portion 40 and a display 50 [col. 3, lines 21-35; col. 5, lines 48-67]. Fig. 2 shows that the telephone set 20 does not mute the loudspeaker 41, but rather intentionally begins to transmit a locally originated signal, called the Local Signal [col. 4, lines 24-67], wherein the Local Signal is predetermined comfort signal 80 providing the user with an audible notification [col. 5, lines 1-14; col. 4, lines 47-51].

Claim 9 is essentially similar to Claim 1 and is rejected for the reasons stated above apropos of Claim 1.

Regarding Claim 2, the Local Signal may be a predefined comfort signal or it may be a portion of a locally stored message that was being delivered to the loudspeaker 41 [col. 4, lines 32-34; col. 5, lines 15-47].

Claim 10 is essentially similar to Claim 1 and is rejected for the reasons stated above apropos of Claim 2.

Regarding Claim 3, the predetermined signal 80 is generated by a comfort signal generator 36.

Claim 11 is essentially similar to Claim 1 and is rejected for the reasons stated above apropos of Claim 3.

Regarding Claim 4, the telephone set 20 performs some functions including CID information based on the digital data. For display on a display unit 50. the telephone set 20 primarily transmits the Local signal to the loudspeaker 41 while the telephone set 20 is receiving digital data [col. 4, lines 52-59].

Claim 12 is essentially similar to Claim 1 and is rejected for the reasons stated above apropos of Claim 4.

Regarding Claim 5, see a display unit 50 [Fig. 1].

Claim 13 is essentially similar to Claim 1 and is rejected for the reasons stated above apropos of Claim 5.

Regarding Claims 6, 7, Fig. 2 shows that , during the time period T_E, and after a short delay τ_2 following the end of the digital data from the LSO, telephone set 20 stops

transmitting the Local Signal to the loudspeaker 41 and again begins to send the Second Party signal to the loudspeaker 41 [col. 4, lines 47-51].

Claims 14 and 15 are essentially similar to Claims 6 and 7,and are rejected for the reasons stated above.

6. Claims 1 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Furukawa et al [US 20020009073 A1].

Regarding Claim 1, Furukawa et al teaches an IP telephone set 214-4 [Para. 0614]. The telephone set notifies off hook condition to media router 212-2 (Step P241) wherein media router administration unit 1138 reports the off hook notification sent from one IP telephone set to another IP telephone set (Step A325) [Para. 0731; 0769]. Further, the operation of the telephone administration server 1271 is advanced to a waiting state of a Step V16 [Para. 0785]. Then, the telephone set reports the state of the calling operation to the telephone set waiting to make a connection so that the caller gets updated [Para. 0794-0795].

Claim 9 is essentially similar to Claim 1 and is rejected for the reasons stated above apropos of Claim 1.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beamish as applied to claims 1, 9 above, and further in view of Kung et al [US 6,633,635 B2].

Regarding Claim 8, Beamish does not teach an internet protocol (IP) telephone set.

Kung et al teaches multiple call waiting in a packetized communication system , as shown in Figs.1-3, including a broad-band IP-based network [col. 1, lines 9-15] , comprising a broadband residential gateway (BRG) 300 [col. 3, line 30 to col. 4, line 58] ; an announcement server 220 [col. 9, lines 39-46]; and a voice gateway 232 [col. 12, lines 53-67]. Fig. 3 shows a block diagram of a local control apparatus (broadband residential gateway) which can support **IP telephones** [col. 21, lines 41-61]. Further, Kung et al discloses implementing a call queue function wherein the subscriber may use any type of broadband communication device including POTS phone [Abstract; col. 32, lines 49-51].

Beamish anf Kung et al are analogous art because they are from a similar problem solving area, viz. , telephonic communications.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the IP telephone set with Beamish.

The suggestion/motivation for doing so would have been to provide multiple call waiting in an Internet Protocol Telephony Network [col. 1, lines 53-58].

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) Williams et al [US 5,883,891] a method and apparatus for increased quality of voice transmission over the internet [Figs. 1A, 1B; col. 2, lines 47-65].

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Ramnandan Singh whose telephone number is (703)308-6270. The examiner can normally be reached on M-F(8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester Isen can be reached on (703)-305-4386. The fax phone numbers

for the organization where this application or proceeding is assigned are (703)872-9314 for regular communications and (703)872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-0377.

Dr. Ramnandan Singh
Examiner
Art Unit 2644

January 10, 2004

FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600